

**REMARKS**

**General Remarks**

With this Amendment, Applicant amends Claims 15 and 19 and cancels claim 17. No new matter is added. Therefore, Claims 1-16 and 18-21 are all the claims currently pending in the present application.

Information Disclosure Statement. The Examiner indicates that he has not considered the references listed in the Information Disclosure Statement filed July 12, 2004. The Examiner alleges that the IDS fails to comply with 37 C.F.R. § 1.98(a)(3) because it does not include a concise explanation of the relevance. Applicants respectfully note that a copy of a corresponding Japanese Office Action dated April 13, 2004 and an English translation of the pertinent portions thereof, which cites the documents and indicates the degree of relevance found by the foreign patent office was filed in conjunction with the IDS of July 12, 2004. A copy of the filing receipt indicating this filing, along with copies of the IDS and the English translation are filed herewith. Therefore, Applicant respectfully requests that the Examiner consider the references listed in Applicant's IDS of July 12, 2004, and return a duly signed and initialed copy of the PTO-Form 1449 along with the next office communication.

**Claims 1-14**

Claims 1-14 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Ogasawara, U.S. Patent No. 6,577,861 ("Ogasawara").

Claims 1, 6, and 8. Regarding the Examiner's rejection of Claims 1, 6, and 8 over Ogasawara, Applicant submits that the cited reference fails to disclose at least a prepaid card, as

claimed, in which a payable amount of money is registered beforehand. Applicant notes that to be an “anticipation” rejection under 35 U.S.C. § 102, Ogasawara must teach *every element and limitation* of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus Ogasawara must clearly and unequivocally disclose every element and limitation of the claimed invention.<sup>1</sup>

In response to the above argument, presented in Applicant’s Amendment of October 15, 2004, the Examiner first asserts that “the Applicant’s invention is not just the use of a prepaid card with an online shopping method.” (Office Action, p. 8). Applicant agrees with this statement, but submits that this statement is unrelated to the patentability of the present claims over the cited art, and that this statement fails to present any evidence that the cited reference discloses the above-noted claimed limitation of a pre-paid card.

Second, the Examiner asserts that “the reader as disclosed by the reference would have been capable of reading a card including a prepaid card.” (Office Action, p. 8). In this case, the Examiner appears to assert that the claimed limitation is inherent in the disclosure of Ogasawara. Applicant does acknowledge that when a reference fails to expressly disclose each and every element of a claimed invention, as in this case, it can be argued that a reference “inherently” teaches the missing element or elements of the claimed invention<sup>2</sup> However, evidence of

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<sup>1</sup> A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In fact, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

<sup>2</sup> See *In re Oelrich*, 666 F.2d 578, 581 (Fed. Cir. 1981).

inherency in a reference “must make it clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”<sup>3</sup> “Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.”<sup>4</sup> Even if the prior art reference could have equally been used or made with only two possibilities, a patent claim which claims one of the two possibilities will not be anticipated because that limitation was not “necessarily” present in the prior art disclosure.<sup>5</sup> Thus, even if it were assumed in this case that the IC card reader in Ogasawara *could* read a prepaid card, such a disclosure is insufficient to meet the high burden of anticipation, because such an element is not *necessarily present* in Ogasawara.

Third, the Examiner asserts that “Ogasawara would have fairly suggested and taught one of skill in the art that the imbedded card reader of Ogasawara includes the capacity to ‘read’ a card for payment purposes, which include a prepaid card such as an electronic cash card.” In response to this assertion by the Examiner, Applicant again notes that the Examiner has rejected Claims 1-14 under 35 U.S.C. § 102(e), and that rejections under 35 U.S.C. § 102 are proper only

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<sup>3</sup> *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (emphasis added).

<sup>4</sup> *Id.* (citing *In re Oelrich*, 666 F.2d 578, 581 (Fed. Cir. 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214 (C.C.P.A. 1939))) (emphasis in original); see also *Scaltech Inc. v. Retec/Tetra L.L.C.*, 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

<sup>5</sup> See *Finnigan Corp. v. I.T.C.*, 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference that disclosed a set-up for performing only resonance or nonresonance ejection was insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference).

when the claimed subject matter is *identically* disclosed or described in the prior art. Applicant respectfully submits that a statement that a claimed limitation is “fairly suggested” by a reference fails to meet the requirements of a proper §102 rejection.

Therefore, in view of at least the above, Applicant submits that Ogasawara fails to anticipate the present invention as recited in Claims 1, 6, and 8.

Claims 2, 6, 9, and 13. Regarding the Examiner’s rejection of Claims 2, 6, 9, and 13 over Ogasawara, Applicant submits that the cited reference fails to disclose at least transmitting merchandise information to a mobile telephone in response to a request from the mobile telephone, as claimed.

In response to this argument, presented in Applicant’s October 15 Amendment, the Examiner asserts that “Ogasawara would fairly suggest and teach one of ordinary skill that requested merchandise information is transmitted to the shopper from the server.” (Office Action, p. 9). In response to this assertion by the Examiner, Applicant again respectfully submits that the Examiner has rejected Claims 1-14 under 35 U.S.C. § 102(e), and that rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is *identically* disclosed or described in the prior art. Applicant respectfully submits that a statement that a claimed limitation is “fairly suggested” by a reference fails to meet the requirements of a proper §102 rejection. Additionally, Applicant notes that Ogasawara is directed to a system whereby a user utilizes a bar code scanner to read the bar code of selected merchandise from a catalog or from the actual merchandise within a store, and transmits the scanned information from a wireless phone to a server. There is no disclosure in Ogasawara of a server transmitting any information

about any merchandise to a wireless phone. Further, it would be counter-intuitive to include such a feature in the system of Ogasawara because it is disclosed that the user obtains information about the merchandise from a catalog or by the user being able to directly view the merchandise in a store. Therefore, there would be no motivation for including such a limitation where information about merchandise is transmitted to a mobile phone in response to a request by the user.

Therefore, in view of at least the above, Applicant respectfully submits that Ogasawara fails to anticipate the present invention as recited in Claims 2, 6, 9, and 13.

Claims 4, 6, 11, and 13. Regarding the Examiner's rejection of Claims 4, 6, 11, and 13 over Ogasawara, Applicant submits that the cited reference fails to disclose at least a server instructing the delivery of ordered merchandise to a previously-registered address corresponding to the mobile phone, as claimed.

In response to this argument, presented in Applicant's October 15 Amendment, the Examiner first asserts that "delivery of merchandise order online as well as payment is old and well known." (Office Action, p. 9). In response, Applicant submits that, even assuming *arguendo*, that the delivery of merchandise ordered online is well-known, as asserted by the Examiner, such a disclosure fails to anticipate the claimed limitation of delivering merchandise to a pre-registered address corresponding to the mobile phone from which the merchandise was ordered. Ogasawara fails to disclose any delivery of merchandise to an address corresponding to the mobile phone from which the merchandise was ordered.

Second, the Examiner asserts that “the reference does fairly suggest and teach that delivery of merchandise can be included as part of an online order when the shopper is not in the store.” (Office Action, p. 9). In response to this assertion, Applicant again respectfully submits that the Examiner has rejected Claims 1-14 under 35 U.S.C. § 102(e), and that rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is *identically* disclosed or described in the prior art. Applicant respectfully submits that a statement that a claimed limitation is “fairly suggested” by a reference fails to meet the requirements of a proper §102 rejection. Further, Applicant submits that even assuming, *arguendo*, that Ogasawara disclosed that “the delivery of merchandise could be included as part of an online order when the shopper is not in the store,” such a disclosure does not disclose the delivery of merchandise to an address corresponding to a mobile phone from which the merchandise is purchased, as claimed.

Therefore, in view of at least the above, Applicant respectfully submits that Ogasawara fails to anticipate the present invention as recited in Claims 4, 6, 11, and 13.

Claims 2-5, 7, 9-12, and 14. Regarding the Examiner’s rejection of Claims 2-5, 7, 9-12, and 14 over Ogasawara, Applicant submits that, in addition to the above, Claims 2-5, 7, 9-12, and 14 are patentable at least by virtue of their dependence on independent Claims 1, 6, 8, and 13.

Therefore, in view of at least the above, Applicant submits that Ogasawara fails to anticipate the present invention as recited in Claims 1-14 and respectfully requests that the rejection of these claims be reconsidered and withdrawn.

**Claims 15-21**

Claims 15-21 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Ogasawara, in view of “Amazon.com and Sprint First to Offer Internet Shopping on Wireless Phones,” Business Editors, High-Tech Writers, *Business Wire*, December 18, 1999 (“Amazon”). Claim 17 is cancelled.

Regarding the Examiner’s rejection of Claims 15 and 19, Applicant submits that the cited combination of references fails to teach or suggest the delivery of merchandise to an address previously registered in a server and associated with the mobile phone from which the merchandise was ordered, as claimed.

As discussed above, Ogasawara fails to teach or suggest this limitation. The Amazon reference describes that web customers can have purchased items delivered by entering a recipient’s e-mail address. However, like Ogasawara, Amazon fails to teach or suggest the delivery of merchandise to a previously-registered address associated with the mobile phone from which the merchandise was ordered.

Therefore, in view of at least the above, Applicant submits that Claims 15 and 19 are patentable over the cited combination of Ogasawara and Amazon and that Claims 16, 18, 20, and 21 are patentable at least by virtue of their dependence on Claims 15 and 19. Applicant respectfully requests that the rejection of Claims 15-16 and 18-21 be reconsidered and withdrawn.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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